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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,373	01/23/2002	Hartwig Schwier	P01,0294	4347
26574	7590	10/04/2005	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			MILIA, MARK R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,373

Applicant(s)

SCHWIER ET AL.

Examiner

Mark R. Milia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-42 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 2, reference character "19", Fig. 3, reference character "24", Fig. 7, reference character "43", and Fig. 9, reference characters "60" and "61". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "56" has been used to designate both a "Spool File" in Fig.8 and an "EPE Print Processor" in Fig. 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of

the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On page 15, first paragraph, last line, "33" should read "34" and page 19, first line, "43" should read "53". Appropriate correction is required.

4. Claims 21 and 22 are objected to because of the following informalities: Claims 21 and 22 claim dependency from claim 1, which has been cancelled, and the examiner believes the claims were meant to be dependent on claim 20, and as such the examiner will treat claims 21 and 22 as depending from claim 20 in the following rejections. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 30, 31 and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites the limitation "the second document". There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "said document". There is insufficient antecedent basis for this limitation in the claim.

Claim 35 recites the limitation "the second document". There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "said second document". There is insufficient antecedent basis for this limitation in the claim.

Claim 37 recites the limitation "said step of logical linking". There is insufficient antecedent basis for this limitation in the claim.

Claim 38 recites the limitation "the second document". There is insufficient antecedent basis for this limitation in the claim.

Examiner believes that claims 35-38 were meant to be dependent from claim 34 and will treat the above claims as such in the following rejections.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 41 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 43 is directed to a computer program. Such a claim is non-statutory because the terminology "computer program" alone has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium, see MPEP 2106. Examiner suggests amending the claims to read "A computer program embodied in a computer readable medium for performing the steps of..." or "A computer readable medium storing a program for performing the steps of..." or any other similar wording which best clarifies the claim and includes a positive recitation of the computer readable medium.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 20, 21, 25-27, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5562351 to Uematsu.

Regarding claims 20, 41, and 42, Uematsu discloses a system, method, and computer program product for output of data from a computer system to an output device, comprising: providing a master document having a variable data area and having a static data area (see Figs. 1 and 4, column 5 lines 3-16, and column 6 lines 7-23), marking the variable data area (see Fig. 1 and column 6 lines 17-25), inserting variable data into the variable data area to provide a serial data stream with individual documents, said individual documents respectively containing both variable data as well as static data (see Fig. 1 and column 6 lines 7-67), separating said variable data of said serial data stream from said static data on a basis of said marking (see Fig. 1 and column 6 lines 7-67), transmitting said variable data separated from said static data from a first individual document to the output device (see Fig. 1A and column 6 lines 41-63), storing said static data of said first individual document in the output device (see Fig. 3 and column 5 lines 3-19), said static data of following individual documents are not transmitted to said output device (see column 9 lines 6-31), and joining said variable data in turn with the stored static data individual document by individual document in said output device (see Fig. 1 and 10 and column 9 lines 6-31).

Regarding claim 21, Uematsu discloses the system discussed in claim 20, and further discloses wherein said output device is a printer device (see column 4 lines 1-4 and 21-22).

Regarding claim 25, Uematsu discloses the system discussed in claim 20, and further discloses indicating a scope of said master document (see column 6 lines 7-67).

Regarding claim 26, Uematsu discloses the system discussed in claim 20, and further discloses transmitting characteristic data to said output device with said variable data (see column 5 line 3-column 6 line 67).

Regarding claim 25, Uematsu discloses the system discussed in claim 20, and further discloses wherein said characteristic data includes at least one of: position data, font data, and color data (see column 5 lines 26-53).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 29-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu as applied to claim 20 above, and further in view of U.S. Patent No. 5983243 to Heiney et al.

Uematsu discloses (*claim 31*) wherein document data is a page segment (see Fig. 1 and column 6 lines 7-67).

Uematsu does not disclose expressly (*claim 29*) generating said serial data stream in one of the printer languages PCL, Postscript and LCDS, (*claim 30*) wherein

one of said master document and the second document is a document of printer language VDS, (*claim 31*) wherein said document of printer language PDS is one of an overlay and a page segment, (*claim 32*) wherein one of said master document and said second document is a document of print data language LCDS, and (*claim 33*) controlling said data output in one of a Windows system environment and a windows-like system environment via data that are input via a user interface.

Heiney discloses (*claim 29*) generating said serial data stream in one of the printer languages PCL, Postscript and LCDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which PCL and LCDS are a part of), (*claim 30*) wherein one of said master document and the second document is a document of printer language IPDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which IPDS is a part of), (*claim 31*) wherein said document of printer language IPDS is one of an overlay and a page segment (see column 4 lines 35-42, column 5 lines 37-49, reference states the use of overlaying in relation to the variable data and master data as can be seen in claims 7 and 14), (*claim 32*) wherein one of said master document and said second document is a document of print data language LCDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which LCDS is a part of), and (*claim 33*) controlling said data output in one of a Windows system environment and a windows-like system environment via data that are input via a user interface (see Figs. 1 and 2, column 3 lines 25-43, and column 4 lines 21-34).

Uematsu & Heiney are combinable because they are from the same field of endeavor, processing and merging variable data and static data to form an output document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of PDL printer languages in a windows-like system environment as described by Heiney with the system of Uematsu.

The suggestion/motivation for doing so would have been to provide the most accurate print instructions depending on the type of printer that is being utilized for output.

Therefore, it would have been obvious to combine Heiney with Uematsu to obtain the invention as specified in claims 29-33.

12. Regarding claim 34, Uematsu discloses generating a master document (see Figs. 1 and 4, column 5 lines 3-16, and column 6 lines 7-23), linking variable data logically with the master document (see column 5 lines 3-16 and column 6 lines 7-67), and sending the variable data to said output device separated from the data of the master document (see column 6 lines 7-67).

Uematsu does not disclose expressly linking at least one second document logically with said master document; and sending the data of the second document to said output device separated from the data of said master document.

Heiney discloses generating a master document (see Fig. 3 and column 4 lines 21-67), linking at least one second document logically with said master document (see

Fig. 3 and column 5 lines 12-20 and 38-49), and sending the data of the second document to said output device separated from the data of said master document (see Fig. 3 and column 3 line 56-column 4 line 10).

Regarding claims 35-40 Uematsu discloses (*claim 35*) storing the variable data in said output device (see column 5 lines 3-19 and column 6 lines 7-67) and (*claim 39*) wherein said area of said master document is a page region (see Fig. 1 and column 6 lines 7-67).

Uematsu does not expressly disclose (*claim 35*) storing the data of the second document in said output device, (*claim 36*) joining the data of said master document with data of said second document for output of an individual document, (*claim 37*) wherein said step of logical linking ensues via a referencing, (*claim 38*) specifying an area of said master document wherein the second document is to be linked with said master document, and (*claim 40*) wherein said second document is one of an overlay and a watermark document.

Heiney discloses (*claim 35*) storing the data of the second document in said output device (see column 3 line 56-column 4 line 10), (*claim 36*) joining the data of said master document with data of said second document for output of an individual document (see column 5 lines 52-65), (*claim 37*) wherein said step of logical linking ensues via a referencing (see Fig. 3 and column 5 lines 12-20 and 38-49), (*claim 38*) specifying an area of said master document wherein the second document is to be linked with said master document (see column 5 lines 37-49), (*claim 39*) wherein said area of said master document is a page region (see column 5 lines 37-49), and (*claim*

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40) wherein said second document is one of an overlay and a watermark document (see column 5 lines 37-49, reference states the use of overlaying in relation to the variable data and master data as can be seen in claims 7 and 14).

Uematsu & Heiney are combinable because they are from the same field of endeavor, processing and merging variable data and static data to form an output document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the linking of a second document to the master document that acts as the variable data as described by Heiney with the system of Uematsu.

The suggestion/motivation for doing so would have been to provide a broader range of data that can be placed in the variable data section and aid in the automation of variable and static data.

Therefore, it would have been obvious to combine Heiney with Uematsu to obtain the invention as specified in claims 34-40.

13. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu as applied to claim 20 above, and further in view of U.S. Patent No. 5649024 to Goldsmith.

Regarding claim 22, Uematsu does not disclose expressly wherein said marking step of said variable data area ensues by a visually perceptible identification.

Goldsmith discloses wherein said marking step of said variable data area ensues by a visually perceptible identification (see column 2 lines 60-67, column 6 lines 51-57

and column 7 lines 24-35, 48-52, and 61-67, reference shows that text data may be merged with scanned in hardcopy documents at that certain fonts of the merge data may be color highlighted).

Regarding claim 23, Uematsu does not disclose expressly wherein said visually perceptible identification is a chromatic marking.

Goldsmith discloses wherein said visually perceptible identification is a chromatic marking (see column 2 lines 60-67, column 6 lines 51-57 and column 7 lines 24-35, 48-52, and 61-67).

Regarding claim 24, Uematsu discloses wherein said output device is a printer device (see column 4 lines 1-4 and 21-22).

Uematsu does not disclose expressly wherein said marking ensues with a color that lies outside a printable color spectrum of said printer device.

Goldsmith discloses printers (output device) that can take color designated objects and print them in black and white, (see column 3 lines 13-14, as is well known and commonly used in the art especially when a color image or the like is to be printed on a printer only capable of printing in black and white).

Uematsu & Goldsmith are combinable because they are from the same field of endeavor, merging and manipulation of document data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combining the color highlighting of originally black text as described by Goldsmith with the system of Uematsu.

The suggestion/motivation for doing so would have been to allow desired text to stand out in a document that has been created from merging text or graphic data with a master document.

Therefore, it would have been obvious to combine Goldsmith with Uematsu to obtain the invention as specified in claims 22-24.

14. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu as applied to claim 20 above, and further in view of U.S. Patent No. 6473892 to Porter.

Uematsu do not disclose expressly storing said static data in a macro datafile.

Porter discloses storing said static data in a macro datafile (see Fig. 2 and column 8 line 46-column 9 line 13).

Uematsu & Porter are combinable because they are from the same field of endeavor, manipulation and merging of variable data to acquire a desired output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the macro datafile as described by Porter with the system of Uematsu.

The suggestion/motivation for doing so would have been to provide greater flexibility and create more options as a macro can contain a plurality of objects and properties that can be made of use in the merging of data.

Therefore, it would have been obvious to combine Porter with Uematsu to obtain the invention as specified in claim 28.

Conclusion

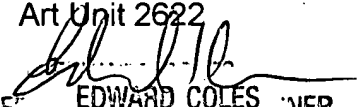
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRM

Mark R. Milia
Examiner
Art Unit 2622

SUPERVISOR EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600